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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,929	04/14/2006	Klaus Schultes	285437US0PCT	7074
22850	7590	10/17/2008	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			REDDY, KARUNA P	
			ART UNIT	PAPER NUMBER
			1796	
			NOTIFICATION DATE	DELIVERY MODE
			10/17/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/575,929	Applicant(s) SCHULTES ET AL.	
	Examiner KARUNA P. REDDY	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-30 and 32-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/26/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in reference to amendment filed 8/28/2008. Claim 1-23 are cancelled; and claim 30 is amended. Accordingly, claims 24-47 are currently pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Objections

3. Claims 30-38 and 40 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

It appears that claim 30 is not properly dependent on claims 24. While the independent claim 24 restricts (meth)acrylate (co)polymer to have a Vicat softening point of at least 104⁰C, the dependent claim 30 is open to a (meth)acrylate (co)polymer with any Vicat softening point.

Claims 31-38 and 40 are subsumed by this rejection because of their dependence on claim 30.

Double Patenting

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4. Claims 24-26, 28-31, 33-40 and 42 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 6-12 of copending Application No. 11/813,946 in view of Lichtenstein et al (US 5, 621, 028).

The rejection is adequately set forth in paragraph 4 of office action mailed 6/4/2008 and is incorporated here by reference.

Claim Rejections - 35 USC § 103

5. Claims 24-25, 30, 32, 35, 37, 39, and 42-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kress et al (US 4,895,898) in view of Lichtenstein et al (US 5, 621, 028)

The rejection is adequately set forth in paragraph 6 of office action mailed 6/4/2008 and is incorporated here by reference.

6. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kress et al (US 4,895,898) in view of Lichtenstein et al (US 5, 621, 028) as applied to claim 24 above, and further in view of Parker (US 5, 252, 667).

The rejection is adequately set forth in paragraph 7 of office action mailed 6/4/2008 and is incorporated here by reference.

7. Claims 24-26, and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albrecht (US 4, 833, 221) in view of Suetterlin et al (US 4, 513, 118) and Lichtenstein et al (US 5, 621, 028).

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The rejection is adequately set forth in paragraph 8 of office action mailed 6/4/2008 and is incorporated here by reference.

8. Claims 33 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kress et al (US 4,895,898) in view of Lichtenstein et al (US 5, 621, 028) as applied to claims 32 and 35 above, and further in view of Albrecht (US 4, 833, 221).

The rejection is adequately set forth in paragraph 9 of office action mailed 6/4/2008 and is incorporated here by reference.

9. Claims 34 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kress et al (US 4,895,898) in view of Lichtenstein et al (US 5, 621, 028) as applied to claim 30 above, and further in view of Suetterlin et al (US 4, 513, 118).

The rejection is adequately set forth in paragraph 10 of office action mailed 6/4/2008 and is incorporated here by reference.

10. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kress et al (US 4,895,898) in view of Lichtenstein et al (US 5, 621, 028) and Suetterlin et al (US 4, 513, 118) as applied to claim 38 above, and further in view of NieSsner et al (US 2001/0007890 A1).

The rejection is adequately set forth in paragraph 11 of office action mailed 6/4/2008 and is incorporated here by reference.

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11. Claims 24, 26-27 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhein et al (EP 0 691 351 A1) in view of Suetterlin et al (US 4,513,118) and Lichtenstein et al (US 5, 621, 028).

The rejection is adequately set forth in paragraph 12 of office action mailed 6/4/2008 and is incorporated here by reference.

Allowable Subject Matter

12. Claim 31 is allowed over the prior art, pending a filing of terminal disclaimer to overcome the obviousness-type double patenting rejection over copending application No. 11/813,946, for the reasons presented in paragraph 13 of office action mailed 6/4/2008 and is incorporated here by reference.

Response to Arguments

13. Applicant's arguments filed 8/28/2008 have been fully considered but they are not persuasive. Specifically, applicant argues that (A) (meth)acrylate polymer (a) having a Vicat Softening point of at least 104⁰C does not preclude the (meth)acrylate (co)polymers of d), f) and g), each having the stated solution viscosity, from the scope of component a) of claim 24; (B) polymer mixture claimed in copending case is different from polymer mixture of present claims. Moreover, present claims require the presence of impact modifier and plastics material; (C) molding composition of Kress et al comprises thermoplastic polycarbonate material in amounts of 20 to 80 parts by weight. Its use in the composition is as a matrix polymer and the present claims do not contain

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such a polycarbonate matrix polymer; (D) component "B" of Kress et al is formed by graft polymerizing a mixture that includes methyl methacrylate as a possible monomer, onto a rubber and no such graft (co)polymer is employed as a component of the present composition; (E) despite the fact that component "B" may be partly composed of a methacrylate monomer, it is not equivalent to either the polymer matrix material or the impact modifier; (F) because of the substantial differences between the relatively simple homo- or co-polymer of methyl methacrylate disclosed in Lichtenstein et al and that in Kress et al, one would not arrive at the present composition as claimed; (G) Albrecht and Rhein et al disclose specific methyl methacrylate copolymers with no disclosure of the necessity of adding other ingredients, such as impact modifier and plastic particles; and (H) Rhein et al does not contain polymeric materials, of present claims, identified as (ii), (iii) and (iv).

With respect to (A), while examiner agrees that (meth)acrylate copolymers d), f) and g) can have the stated solution viscosity, the scope of (meth)acrylate copolymers should also be limited to those (meth)acrylate copolymers having a Vicat Softening point of at least 104°C.

With respect to (B), while claims in copending application are directed to a mixture comprising three different (meth)acrylate (co)polymers with specific solution viscosities, the (meth)acrylate (co)polymers in present claims are broader and encompass the (meth)acrylate (co)polymers of copending application. Furthermore, copending claims also comprise impact modifier and after *Graham v. John Deere* analysis was done, Lichtenstein was brought in as a secondary reference to incorporate plastic particles into the polymer mixture.

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With respect to (C), examiner reiterates that, while use of transitional phrase “consisting essentially of” narrows scope of the polymer matrix to the specified materials and those which do not materially affect the basic and novel characteristics of the claimed invention, absent a clear indication of what the basic and novel characteristics are, “consisting essentially of” is construed as equivalent to “comprising”. Further, the burden is on the applicant to show that the additional ingredients in the prior art, i.e. polycarbonate, would in fact be excluded from the claims and that such ingredients would materially change the characteristics of the applicant’s invention, See MPEP 2111.03. Moreover, the statement “present claims do not contain fundamentally different thermoplastic polycarbonate” in applicant’s invention is a conclusory statement with no evidentiary weight, i.e., attorney’s statements are not a substitute for factual evidence. Case law holds that “[i]f an applicant contends that additional steps or material in the prior art are excluded by the recitation of ‘consisting essentially of,’ applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant’s invention.” *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). Applicant is advised to submit clear and convincing evidence in the form of a declaration that presence of thermoplastic polycarbonate would materially affect the basic and novel characteristics of applicant’s invention. In addition, the present claims are directed to a “polymer mixture” and use of transitional phrase “comprising” to describe the “polymer mixture” is open-ended and can include other component such as polycarbonate in an amount of 20-80 percent weight.

With respect to (D), claims as recited do not exclude graft polymers as impact modifiers. The present claims only require impact modifier to be a crosslinked

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poly)meth)acrylate that is not covalently bonded to the polymer matrix. The acrylate rubber materials disclosed in Kress et al are crosslinked and not bonded to other polymers in the mixture.

With respect to (E), applicant's attention is drawn to Kress et al (column 4, lines 55-65) wherein it disclosed that alkyl acryate rubbers based on C₁-C₈ alkyl acrylates are also suitable as rubbers and these alkyl acrylate rubbers can contain minor amounts of ethylenically unsaturated monomers which have a crosslinking action. Thus, it is apparent that the rubbery alkyl acrylate of Kress et al which can function as an impact modifier can be made mostly of presently claimed polyacrylates that are crosslinked.

With respect to (F), Lichtenstein is only used for its teaching that polystyrene can be added as a light scattering agent to molded articles that comprise polymethyl methacrylate and thus render them translucent rather than transparent. It is noted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references i.e. Kress et al and Lichtenstein et al. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

With respect to (G), applicant's attention is drawn to paragraphs 8 and 12 of office action mailed 6/4/2008, where Graham v. John Deere analysis was done and motivation to add the impact modifier of Suetterlin et al and the plastic particles of Lichtenstein et al was provided. Furthermore, neither Albrecht nor Rhein et al use closed language to eliminate the addition of other components such as impact modifier of Suetterlin et al and plastic particles Lichtenstein et al.

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With respect to (H), examiner maintains that polymer materials identified as (ii), (iii) and (iv) are not required in the rejected claims and are only alternative components for the polymer matrix i.e. polymer matrix can be either (i) or (ii) or (iii) or (iv).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KARUNA P. REDDY whose telephone number is (571)272-6566. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. P. R./
Examiner, Art Unit 1796

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796